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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,615	12/05/2003	Ronald J. Mathis	111440.02	7898

32047 7590 03/22/2007
GROSSMAN, TUCKER, PERREAULT & PFLEGER, PLLC
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EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/727,615

Applicant(s)

MATHIS ET AL.

Examiner

Ellen M. McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,8,9,12-20 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,8,9,12-20 and 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-17 are still provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/684,427. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of producing the lubricious coating comprising a polymer particle and water may be the same and the coating may be applied to a target surface wherein water may be added immediately prior to or after applying the coating to a target surface.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants' response that they are prepared to file a terminal disclaimer to overcome this rejection upon the indication of allowable subject matter has been noted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-6, 8, 9, 12-20 and 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harlukowicz et al (6,642,351) alone or in combination with Yagi et al (5,258,424).

Applicants' arguments filed 28 December 2006 have been fully considered but they are not persuasive. As previously set forth, Harlukowicz et al ["Harlukowicz"] disclose polymer compositions comprised of small, dry polyacrylamide particles dispersed into water at industrially useful rates to form aqueous compositions. The resulting aqueous compositions may be used as a treating solution in diverse applications such as flocculants in water treating, papermaking, mining, oil field, and biotechnological separations. Harlukowicz teaches that the dispersal of polymer particles in water is achieved by separating the dry polyacrylamide particles from each other to form an airborne stream of separated polyacrylamide particles, then contacting the airborne stream with a stream of flowing water to form the desired aqueous compositions. Harlukowicz teaches that the polyacrylamides may be prepared by using techniques generally well-known to those skilled in the art including polymerization in solution, water-in-oil emulsion, water-in-oil microemulsion or aqueous dispersion. See column 4, lines 42-55. Harlukowicz teaches that the polyacrylamide particles have a particle size of about 300

microns or less, preferably 150 microns or less. See column 4, lines 56-66. Harlukowicz teaches that in some cases, the aqueous composition may contain more than 5% of dispersed polymer by weight. See column 6, lines 53-60. The examiner maintains the position that the aqueous compositions of Harlukowicz meet the limitations of the compositions of the above rejected claims. Although a coating composition is not specifically set forth, the term "coating" is found in the preamble which is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Harlukowicz teaches that the aqueous polyacrylamide compositions may be added to suspended solids such as biological solids, mineral slurry, oily water and cellulosic slurry. See column 9, lines 3-8. Thus the examiner is of the position that Harlukowicz meets the limitations of independent claim 18 which comprises the polymer particles in oil. The open-ended claim language "comprising" allows for the addition of other additives to the composition, even in major amounts, such as water.

Applicants' invention may differ in some dependent claims by applying the aqueous composition to a target surface which is not set forth in Harlukowicz. However, Yagi et al ["Yagi"] is added to teach that aqueous compositions containing polyacrylamide particles may be applied to surfaces where it may act as a coating. Thus the examiner is of the position that it

would have been obvious to the skilled artisan to have applied the aqueous compositions of Harlukowicz to a surface if so desired.

In response applicants amended independent claims 1 and 18 to add the language that the water and polymer particles (claim 1) and the glycerol or oil and polymer particles (claim 18) form an anti-traction material “in the form of a viscous gel coating” and argue that Harlukowicz teaches the importance of avoiding the formation of “fisheyes” or “globules”. Applicants argue that a globule is generally understood to be a spherical viscous mass which may contain incompletely dissolved polymer, which also corresponds to a gel. This is not deemed to be persuasive because independent claims 1 and 18 are drawn to compositions comprising polymer particles having a mean particle size of about 10 microns to 500 microns and either water (claim 1) or glycerol or oil (claim 18). No amounts of the polymer particles are cited in the independent claims; however, several of the dependent claims cite a ratio of water (or glycerol or oil) to polymer particles ranging from about 7:1 to about 16:1 which corresponds to about 6% to about 12.5% polymer particles. As set forth above, Harlukowicz teaches that the aqueous compositions may contain more than 5% of the dispersed polymer by weight. See column 6, lines 58-59. Thus the examiner is of the position that “more than 5%” of the prior art is indistinguishable from “about 6%” of the claims. The newly added language that the compositions are “in the form of a viscous gel coating” does not distinguish over the prior art since the compositions may be essentially the same, i.e., water, the same polymer particles (polyacrylamides), the same size polymer particles and the same amount of polymer particles.

The examiner is of the position that the aqueous compositions of the prior art containing more than 5% of the dispersed polymer are also in the form of a “viscous gel”.

Applicants also argue that Harlukowicz teaches that the aqueous polyacrylamide composition could be added to suspended solids, mineral slurries, oily water and cellulosic slurry apparently for the sole purpose of flocculating suspended solids. Applicants argue that Harlukowicz does not teach or even suggest that his aqueous compositions would be suitable to form an anti-traction coating composition comprising a viscous gel coating. This is not deemed to be persuasive because the independent claims are drawn towards compositions and not towards methods of forming a coating. Further, as set forth above, Yagi is added to teach that aqueous compositions containing polyacrylamide particles may be applied to surfaces where it may act as a coating. The examiner maintains the position that it would have been obvious to the skilled artisan to have applied the aqueous compositions of Harlukowicz to a surface to form a coating if so desired.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

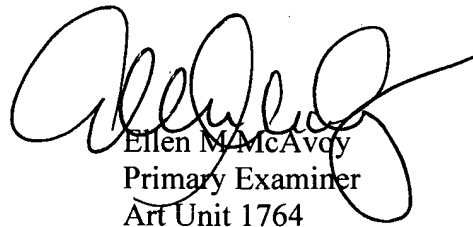
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ellen M. McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
March 13, 2007